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09/477,977	01/05/2000	JOHN H. BURTON	825.001US2	1025

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EXAMINER

KEARNEY, ROSILAND STACIE

ART UNIT

PAPER NUMBER

3739

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. ²⁰~~19~~

Application Number: 09/477,977
Filing Date: January 05, 2000
Appellant(s): BURTON ET AL.

Timothy Bianchi
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/14/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-24, 26-37, 39, and 40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4553959	Hickey et al.	11-1985
4846784	Haber	4-1989
4559043	Whitehouse et al.	12-1985
5334153	McIntyre et al.	8-1994
5634877	Salama	6-1997
5637074	Andino et al.	6-1997

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 5, 6 and 8 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 10

Claims 13-17, 19-24, 27-32, 34-37, 39 and 40 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 10.

Claims 2 and 7 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

Claim 4 is rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

Claims 18 and 33 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

Claim 26 is rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

(11) Response to Argument

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Applicant argues that Hickey et al. does not teach a device adapted for implantation within body tissue with the expandable element adjacent a body lumen. The word "implant" is defined in *Stedman's Medical Dictionary* as "to graft or insert". Given the definition of implant, the Examiner concludes that the device of Hickey et al. is implanted into the urethra, which constitutes being implanted into tissue. Furthermore, Hickey et al. disclose closing the bladder neck, which is coapting of a body lumen. Regarding claim 5 the elongate conduit of Hickey et al. allows subcutaneous positioning of the rear port portion. Regarding claim 6 Hickey et al. disclose the same biocompatible material in col. 2 line 33 as recited by Applicant. Regarding the argument pertaining to claim 8, Hickey et al. disclose a device for adjustably closing the bladder neck.

Applicant argues that motivation for the combination of Hickey and Whitehouse is not provided in the rejection. In paragraph 5 lines 5-8 Examiner provides motivation for the combination of Hickey and Whitehouse.

Applicant argues that Hickey does not relate to a flexible guidewire as recited in claim 10. Hickey discloses the use of a rod to place the catheter in the body (see col. 3 lines 14-16) which relates to the teaching of a guidewire.

Applicant argues that Haber does not teach providing a flowable material from a source into the port portion at the rearward end of the elongate implantable device. Applicant has concluded from figure 9 of Haber that the flowable material is delivered directly to balloon 2. In col. 5 lines 41-44 Haber discloses a flowable material being provided from a source (needle) into a port (the proximal end of the cannula) at the

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rearward end of the device as claimed. Haber discloses a port portion near the surface of skin and closing an opening in col. 6 lines 1-24. Regarding guidance over an elongate member please see reference (4).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rosiland Kearney Rollins

ROSILAND S. KEARNEY
PRIMARY EXAMINER

RKR
May 5, 2003

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